

Notice of Allowability

Application No.
08/872,078

Applicant(s)
JEFFREY et al

Examiner
William Luther

Art Unit
2664

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/7/2000
2. ☒ The allowed claim(s) is/are 9-14 renumbered as 1-6
3. ☐ The drawings filed on _____ are acceptable as formal drawings.
4. ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/990,737
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

5. ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE FOR SUBMITTING NEW FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION.** This three-month period for complying with the REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL is extendable under 37 CFR 1.136(a).

6. ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

7. ☒ Applicant MUST submit NEW FORMAL DRAWINGS

- (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☒ Paper No. 4
- (b) ☒ including changes required by the proposed drawing correction filed May 25, 1994, which has been approved by the examiner.
- (c) ☐ including changes required by the attached Examiner's Amendment/Comment or in the Office action of Paper No. _____

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

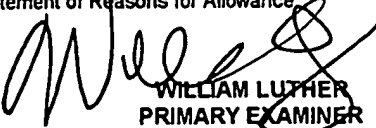
8. ☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any reply to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

- 1 ☐ Notice of References Cited (PTO-892)
- 3 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 5 ☐ Information Disclosure Statement(s) (PTO-1449), Paper No(s) _____
- 7 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 9 ☐ Other

- 2 ☐ Notice of Informal Patent Application (PTO-152)
- 4 ☐ Interview Summary (PTO-413), Paper No. _____
- 6 ☐ Examiner's Amendment/Comment
- 8 ☒ Examiner's Statement of Reasons for Allowance


WILLIAM LUTHER
PRIMARY EXAMINER
ART UNIT 2664

Art Unit: 2664

1. The following is an examiner's statement of clarification for the record and reasons for allowance. The instant U.S. Patent Appl. 08/872,078('078) was filed on June 10, 1997, and is a "continuation" of its parent U.S. Patent Appl. 08/400,140 ('140) which was filed on March 6, 1995. (U.S. Appl. '140 was expressly abandoned when U.S. Appl. '078 was filed.) U.S. Appl. '140 was a "continuation-in-part" of its parent U.S. Patent Appl. 07/990,737 ('737) which was filed on December 15, 1992. (U.S. Appl. '737 was expressly abandoned when U.S. Patent Appl. '140 was filed on March 6, 1995.) Additionally, U.S. Appl. '737 was based on the foreign application 9200267.4 (Great Britain) which was filed on January 8, 1992.

The applicants claim priority benefit under 35 U.S.C. 120 (for the instant Appl. '078) to its "grand-parent" patent application's filing date of December 15, 1992 or when the "grand parent" U.S. Appl. '737 was filed (i.e., priority benefit is thus claimed from instant U.S. Appl. '078 through U.S. Appl. '140, and to U.S. Appl. '737). Notwithstanding, the applicants also claim priority benefit under 35 U.S.C. 119 from U.S. Appl. '737 to its foreign patent application 9200267.4 which was filed on January 8, 1992. It is well settled in patent law that 35 U.S.C. 120 and 35 U.S.C. 119 are "symmetrical," and thus that the claimed invention is entitled to the January 8, 1992, effective filing date when the claimed invention satisfies the same statutory requirements. See Transco Prods. v. Performance Contracting 38 F.3d 551 (Fed. Cir. 1994), cert. denied, 513 U.S. 1151 (1995).

Art Unit: 2664

Section 120, titled "Benefit of Earlier Filing Date in the United States," provides (emphasis added):

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Accordingly, 35 U.S.C. 120 requires: 1) coinventorship, 2) copendency, 3) disclosure "continuity" (i.e., "common subject matter") consistent with the first paragraph of section 112; and 4) and specific reference to the earlier filed applications. Bauman 683 F.2d 405 (Fed. Cir. 1982). A U.S. patent application is entitled to the benefit of the filing date of an earlier application only as to "common subject matter." See Transco Prods. v. Performance Contracting 38 F.3d 551, 556 (Fed. Cir. 1994), cert. denied, 513 U.S. 1151 (1995). The primary examiner recognizes that the applicants must therefore rely only on "common subject matter" between U.S. Appl.'s '078, '140, and '737, and foreign patent application 9200267.4, which alone satisfies the first paragraph of section 112 for each application's specification (in the entire chain of applications).

As related to these basic requirements of section 120 with respect to "common subject matter," the applicants had previously been notified that parent U.S. Appl. '140 did not meet the

Art Unit: 2664

requirements of then 37 C.F.R. 1.62. This "notice," which was issued on April 6 1995, also stated that U.S. Appl. '140 was not granted a filing date. The applicants replied to this notice with a petition which was filed on March 17, 1995. The petition purported as follows:

[the PTO found that U.S. Appl. '140 did not meet the requirements of] Rule 62 [because U.S. Appl. '140's disclosure] "included a new specification or a copy of a specification from the prior application". This is an erroneous finding. (Emphasis omitted.) See first paragraph.

The PTO then granted this petition on August 18, 1995. However, the facts identified and stated in August 18, 1995, petition's answer provided an insufficient basis to support the petition's allegation that U.S. Appl. '140 satisfied the regulatory requirements of then 37 C.F.R. 1.62. More specifically, the primary examiner firmly disagrees with the petition's position and the identified fact basis which was stated in the answer which granted this petition's demand. U.S. Simply, U.S. Appl. '140 does not appear to have satisfied the regulatory requirements provided for by then 37 C.F.R. 1.62 in that U.S. Appl. '140 was, in fact, a continuation-in-part of its parent U.S. Appl. '737.

The April 17, 1995, petition had purported that U.S. Appl. '140 was a proper continuation application under then 37 C.F.R. 1.62, and should have been accorded a filing date of March 6, 1995. The PTO responded to the petition with an answer which was issued on August 18, 1995. The August 18, 1995, answer, "granted" the petition's demand. The August 18, 1995, answer stated as follows:

Art Unit: 2664

“[the] petitioners argue that the [April 6, 1995] notice was mailed in error since a new specification or copy of a specification from the prior application was not filed. Petitioners explain that the specification that was objected to was a part of the preliminary amendment filed March 6, 1995. Accordingly, petitioners requires that the application be accorded a filing date under 37 C.F.R. 1.62 and that the petition fee be refunded . . . A review of the record confirms that the “specification” was a part of the preliminary amendment filed on March 6, 1995. Therefore, the petition is granted.” See the third paragraph.

The primary examiner does not understand the basis provided by the answer for granting the petition. More so, the August 18, 1995, answer implies that the parent U.S. Appl. ‘140 was a properly filed application under then 37 C.F.R. 1.62 merely because the amendment to ‘140's specification was filed on that application's filing date of March 6, 1995. However, this implication is not supportable.

It appears that both the petition and its answer have missed the mark. More specifically, the fact recognized by the petition's answer (i.e., that the “specification” amendment was filed on March 6, 1995) is insufficient in itself to establish that U.S. Appl. ‘140 was not a “continuation-in-part,” or that U.S. Appl. satisfied the requirements of then 37 C.F.R. 1.62. That fact merely established that the subject matter which was added by the preliminary amendment on March 6, 1995, did not violate certain statutory prohibitions (e.g., the “new matter” prohibition provided for under title 35 such as under 35 U.S.C. 132). However, in order to determine whether U.S. Appl. ‘140 satisfied the requirements provided for under then 37 C.F.R. 1.62, it would have been necessary to determine whether the four corners of U.S. Appl. ‘140's specification were identical

Art Unit: 2664

to U.S. Appl. '737's specification. Although the amendment to the specification of U.S. Appl. '140 on March 6, 1995 was made at the time of filing the application, the March 6, 1995, ~~410~~ amendment actually omitted subject matter which had been previously disclosed in its parent applications' specifications.

More specifically, the preliminary amendment in question (i.e., filed March 6, 1995) added subject matter that had previously been "incorporated by reference" in the preceding chain of applications including its parent U.S. Appl. '737, and the foreign application 9200267.4. It is well settled in patent law that the term "incorporation-by-reference" is a short hand notation for including that subject matter into the four corners of an application's specification (i.e., into U.S. Appl. '737's specification, as well as 9200267.4's specification). It should thus be clear that specifically including that subject matter into U.S. Appl. '410's specification is not inconsistent with satisfying the requirements of then 37 C.F.R. 1.62, since such subject matter is "common subject matter" to both U.S. Appl. '737's specification, as well as foreign application 9200267.4's specification. However, all of the subject matter from U.S. application's '737's specification should have been either specifically included or expressly incorporated by reference into U.S. Appl. '410's specification on March 6, 1995.

The regulatory error appears to be as follows. The petition requested that U.S. Appl. '140 be recognized as properly filed under then 37 C.F.R. 1.62. The petition did not establish that

Art Unit: 2664

the applicants maintained continuity of "common subject matter" of the entire specification of U.S. Appl. '737 when the applicants filed U.S. Appl. '140's specification. More specifically, U.S. Appl. '737's specification and foreign application 9200267.4's specification had "incorporated by reference" four documents (see, e.g., U.S. Appl. '737's specification at page 3 line 9; see also foreign application 9200267.4's specification at page 3 line 5). However, the preliminary amendment in question which was filed on March 6, 1995, merely included subject matter from three of these four documents. Accordingly, U.S. Appl. '140's specification did not contain all of the subject matter which has previously been disclosed in its parent U.S. Appl. '737's specification, or foreign application 9200267.4's specification. Therefore, U.S. Appl. '140 could not be considered to have satisfied the regulatory requirements of then 37 C.F.R. 1.62, and must be considered a "continuation-in-part" in that U.S. Appl. '140's specification did not include all of the subject matter which has previously been disclosed in U.S. Appl. '737's specification .

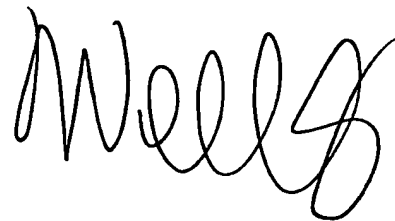
In view of the above and in view of the fact that the prior art of record does not appear to suggest the entire claimed combination. The claimed invention appears to be patentable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 2664

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Luther whose telephone number is (703) 308-6609.

William Luther
Primary Examiner
August 13, 2001

A handwritten signature in black ink, appearing to read 'Wells', is written over the typed name 'William Luther'.